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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,906	01/22/2002	Hendrik Antonius Hoogland	294-106PCT/US	7316
7590	04/04/2006		EXAMINER	
Ronald J Baron Hoffman & Baron 6900 Jericho Turnpike Syosset, NY 11791			JOHNSON, JERROLD D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,906

Applicant(s)

HOOGLAND ET AL.

Examiner

Jerrold Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 and 39-41 is/are pending in the application.
- 4a) Of the above claim(s) 1-18, 29-31, 34-37 and 39-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 19-28, 32 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 24 April 2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

A review of the Restriction dated 13 December 2005 has found that the following claims were not properly set forth. Claim 5 should be included in Group 2. Claim 30 should be included in Group 6. Claim 31 should be included in Group 7. Additionally, Claim 29 should have been set forth as Group 15 (page 7 of the specification sets forth that this claim is directed to another embodiment of the invention). Claims 32 and 33 should have been included in Group 12.

Accordingly, Claims 2-18, 29-31, 34-37 and 39-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 02 February 2006. Claim 38 has previously been cancelled by the applicant.

Applicant's election with traverse is acknowledged. Applicant's arguments with respect to the Restriction Requirement are addressed within the body of the claim rejections that follow. The requirement is still deemed proper and is therefore made FINAL.

Specification

The disclosure is objected to because of the following informalities: References to the claims in the specification are improper. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butcher WO 98/19305 in view of Palmer et al. US 5,189,531 and Examiner Official Notice.

Butcher discloses the method of manufacturing a storage device for plate shaped data carriers. On page 10, lines 37-31, Butcher describes adding information holograms to the storage device for the purposes of in-store security tagging. Butcher describes just one method for adding images to the storage device, which is within the single injection molding operation.

Butcher does not specifically disclose that a portion of the storage device is formed against or around the hologram, however this is clearly inferred by Butcher. Butcher also does not specifically disclose that the hologram cannot be removed from

the relevant part without damage, although a hologram provided in a single molding operation as taught by Butcher would likely necessarily be damaged in this way.

Finally, Butcher does not disclose that the information in the data carrier is incorporated into the hologram.

With respect to this limitation, limitations drawn to the content of indicia are typically treated in the same manner as "printed matter." It is noted that the specific contents of the indicia in the current claims do not confer patentable limitations on the claims, but instead fall under the category of printed matter in that no new and unobvious functional relationship exists between the printed matter (the incorporation of product information into the protective means) and the substrate (the storage device).

In the determination of whether the printed matter is functionally related to the container, reference is made to the following two Federal Circuit decisions: *In re Gulack*, 703 F.2d. 1381 [217 USPQ 401] (Fed. Cir. 1983), and *In re Ngai* 70 USPQ 2d 1862 (CA FC 2004).

Quoting *Gulack*, "The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate." *Id.* at 1386.

The CAFC determined that in *Gulack* there was not merely a functional relationship between the printed matter and the substrate, but that the printed matter and the substrate were functionally interrelated, and that there was a new and unobvious functional relationship between the substrate and the instructions.

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The CAFC stated within the *in re Ngai* decision "In Gulack, the printed matter would not achieve its educational purposes without the band, and the band without the printed matter would similarly be unable to produce the desired result." *Id.* at 1864.

In the present application, like *Ngai*, there is no new and unobvious functional relationship between the substrate (the storage device) and the printed matter (product information in the protective means). In *Ngai*, the court stated that "the printed matter in no way depends on the kit, and the kit does not depend on the printed matter."

Similarly, in the present application, the storage device is suitable to perform the function of a storage device in the manner described in the specification irrespective of the product information in the protective means.

Accordingly, although an art rejection has been set forth in the rejection of the specific recitations or the indicia (the product information in the protective means) within the claims, it is understood that a teaching of *any* indicia within the message display area would suffice to reject these limitations. Butcher does in fact suggest that the holograms are information-bearing, and therefor meets this limitation.

Butcher does not disclose the first and second cover pivotally connected and the fixing means.

The Examiner takes Official Notice that this configuration of a storage device is the common configuration, and it would have been obvious to one of ordinary skill in the art to use the teachings of Butcher to the common configuration so as to maximize the commercial benefits of this concept.

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To the extent necessary, Palmer et al. discloses the exact method step of forming a portion of a molded product against or around a protective means (hologram) in an injection molding step.

Accordingly, it would have been obvious to one of ordinary skill in the art to use the teachings of Palmer within the storage device of Butcher so as to minimize manufacturing steps.

Re the limitation in claims 1 and 20 drawn to the specific shape of the storage device, it is acknowledged that Butcher discloses a one piece storage device. However, one piece storage devices having first and second covers integral with each other are also well known. Again, the inventive concepts of Butcher are transferable to many known storage device configurations such as that of claims 1 and 20.

Claims 21-28, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butcher WO 98/19305 in view of Palmer et al. US 5,189,531 and Examiner Official Notice and further in view of Sammet US 4,978,005.

Sammet discloses adding printing 18 to a storage device. Sammet does not disclose the manner in which the printing is produced on the storage device.

Re claims 21-28, 32 and 33, these claims set forth the known method steps of what is known in this art as in mold labeling which is commonly used to apply printing and other indicia to storage containers of all types. The Examiner takes Official Notice that the method steps disclosed in these claims are well known.

The following references provide extrinsic evidence of the Examiner's Official Notice: Kuramitsu et al. US 5,082,435; Hanamoto et al. US 4,639,341; and Yamanaka US 5,254,302.

It would have been obvious to use this common technique to apply printing as the technique is well known, and as equipment for performing the technique are commercially available.

The Examiner believes that the specific subject matter set forth in claims 21-28, 33 and 34 was not likely intended to be set forth as an inventive concept representing the work of the Applicant. Instead, the Examiner believes that the subject matter set forth in these claims was known to be prior art subject matter incorporated into the broad invention set forth in claims 1 and 19. The Examiner's belief on this matter is informed by the fact that this complicated process is disclosed in a *single* paragraph in the specification. If this understanding is correct, please confirm this fact so that the examination of the inventive concept set forth in claim 19 is not diluted by an unnecessary effort being made to examine limitations within claims 21-28, 32 and 33, which the applicant considers to be prior art. It is noted that applications filed in class 206 often include numerous dependent claims drawn to known prior art subject matter, and that examination of the inventive concepts within these applications is hindered by an absence of disclosure that the subject matter in certain dependent claims is known to be prior art. Additionally, it is also the Examiner's belief that the inventive concept set forth in claim 1 and 19 is not the particular process/structure of placing a protective means into a molded storage device broadly per se. Instead, the Examiner believes

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that the inventive concept is specifically that of the inclusion of product information into a protective device that has been integrally molded into a storage device, thus providing a protection against counterfeiting and theft that would not exist in the absence of this information. Please advise the Examiner on these understandings. If the Applicant believes that the specific structures/processes (absent the inclusion of product information) are known in the prior art, this would be helpful to the Examiner in determining patentability of the presented claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerrold Johnson whose telephone number is 571-272-7141. The examiner can normally be reached on 9:30 to 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mickey Yu
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